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Supreme Court, U.S.
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No. 09-365

IN THE
Supreme Court of the United States

CORDIS CORPORATION,

Petitioner,

v.

BOSTON SCIENTIFIC CORPORATION
and BOSTON SCIENTIFIC SCIMED, INC.,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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QUESTION PRESENTED

The petition for certiorari presented the following question:

1. Was it proper for the district court to enter judgment based on a verdict of patent infringement under the doctrine of equivalents where it is undisputed that the accused product contained, if not literally every patent element, at a minimum a known interchangeable substitute for the one allegedly absent element, and where neither party objected to the question of infringement by equivalence being submitted to the jury?

CORPORATE DISCLOSURE STATEMENT

Pursuant to this Court's Rule 29.6, respondents Boston Scientific Corporation and Boston Scientific Scimed Inc. (formerly known as Scimed Life Systems, Inc.) state that Boston Scientific Corporation is a publicly held company and a parent corporation that owns 10 percent or more of the stock of Boston Scientific Scimed, Inc., and that no parent corporation or publicly held company owns 10 percent or more of Boston Scientific Corporation.

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INTRODUCTION

Cordis' Petition concerns a narrow issue of interest only to the parties to this case—whether the "rounded corners" in Cordis' stents were properly deemed equivalent to the "corners" recited in Boston Scientific's patent.

Cordis' Petition shows that there is no genuine dispute as to the equivalence found by the jury—the two structures are known to be "interchangeable substitutes." As Cordis does not dispute, substantial evidence was adduced at trial that Cordis' "rounded corners" performed substantially the same function in substantially the same way to achieve substantially the same result as the patent's "corners"—a test this Court has repeatedly endorsed as one way to assess and apply the doctrine of equivalents.

Notably, any difference between "corners" and "rounded corners" is inapposite to the invention in Boston Scientific's patent. As discussed herein, the patent's use of offset, curvy connectors distinguished it over the prior art and achieved a combination of strength and flexibility that others had tried—and failed—to achieve for many years. For example, Cordis was only able to reverse a string of disappointing products after meeting with the inventor of Boston Scientific's patent, learning of his designs, and then launching the accused products. The doctrine of equivalents exists for just such cases—to prevent alleged infringers from escaping liability for patent infringement by making an insubstantial alteration.

Cordis argues that—notwithstanding this factual record—it was somehow improper as a matter of law

for the jury to consider infringement under the doctrine of equivalents. This new argument was not timely raised in the district court and was waived. Cordis did not move for summary judgment regarding the doctrine of equivalents. Cordis did not move in limine to exclude evidence and argument regarding equivalents for the "corners" limitation. Cordis did not object to the question of infringement by equivalents being submitted to the jury. And Cordis did not object to the instruction used to charge the jury. Cordis' failure to object constitutes waiver and is fatal to Cordis' Petition *ab initio*.

If considered on the merits, Cordis' Petition is still properly denied. Cordis argues that the doctrine of equivalents should somehow be barred in this case because the structures were known to be equivalent at the time of patenting. This argument is without merit. For over 100 years, this Court has repeatedly held that the doctrine of equivalents applies in such circumstances.

Cordis argues that this Court's 2002 decision in *Festo* somehow implicitly abrogated this century of precedent. But *Festo* addressed the scope of prosecution history estoppel, and is inapposite here where no such estoppel is claimed. Indeed, the relevant claim of Boston Scientific's patent was allowed without any rejection. There was no rejection and no amendment to Boston Scientific's patent regarding the "corners" limitation, and thus no possible surrender of patent scope. *Festo* is inapposite.

Cordis' argument that the holding of *Festo* somehow extends beyond prosecution history estoppel finds no basis in the text of *Festo* nor in any

subsequent case or commentary. There is no confusion among the courts. Nor are there any conflicting decisions. In fact, the only known case that has addressed the question raised by Cordis' Petition rejected Cordis' argument.

Cordis' Petition seeks to reverse over 100 years of this Court's jurisprudence on the doctrine of equivalents. Cordis argues that this reversal is somehow necessary to prevent uncertainty for potential infringers. But the doctrine's balance between patentees' rights and potential infringers' certainty was set by the Court at the inception of the doctrine of equivalents 150 years ago. And it has been reaffirmed in every subsequent decision. The purpose of the doctrine of equivalents is to extend patents beyond their strict, literal scope. Were the rule otherwise, infringers could escape liability for patent infringement by making a single, insubstantial alteration.

This case presents facts squarely within the 150 years of this Court's precedent: Cordis met with Dr. Jang, learned of his stent designs and then launched a new product that differed from Dr. Jang's patent only by an insubstantial modification to one limitation. These facts offer no reason to change the balance this Court has long maintained. Indeed, this Court has repeatedly, and explicitly, deferred to Congress for any fundamental modifications of the doctrine of equivalents, such as that requested by Cordis. Cordis offers no basis for the Court to revisit that conclusion. Cordis' Petition is properly denied.

COUNTERSTATEMENT OF THE CASE

I. Background

Respondent Boston Scientific is a world-wide leader in the design and development of stents for the treatment of coronary artery disease. Coronary artery disease can result from a build-up of plaque in a patient's blood vessels, constricting the blood flow reaching the heart's muscle tissue. This can lead to chest pain, shortness of breath and—in extreme presentations—heart attack and even death.

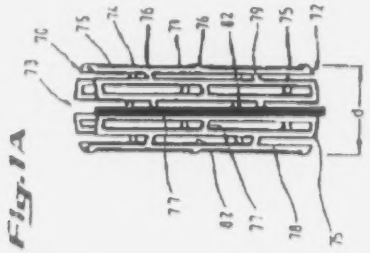
Balloon angioplasty has been used for decades to treat coronary artery disease. A catheter is inserted into a relatively non-invasive entry site—such as the femoral artery in the leg—and threaded through the patient's vasculature to the site of blockage. A balloon on the catheter is then inflated, compressing the plaque against the vessel wall to reopen the blood vessel. The balloon catheter is then deflated and removed. This offers a faster and much less invasive option than coronary artery bypass surgery, one of the few alternative treatments previously available.

Stents are metal scaffolds delivered in conjunction with balloon angioplasty. When the balloon expands, the scaffold also expands to provide a mechanical support inside the blood vessel. This prevents blood vessels from elastically re-narrowing once the balloon is removed, and also prevents loosened plaque from blocking blood flow.

A. Prior to Dr. Jang's invention, there was a long-felt need for stents that were both flexible and strong.

By the mid-1990's, many companies were trying to develop stents that were both flexible enough to be delivered through a patient's tortuous vasculature, yet strong enough to hold open a diseased artery once deployed. Although the need for achieving both of these properties in a single device was known, the stent industry was unable to achieve this combination for years, if not decades.

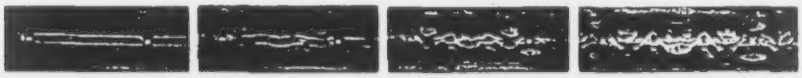
Cordis was one of the companies trying to achieve this combination of strength and flexibility. Cordis' stents of this era were based on the Palmaz patents, discussed in Cordis' Petition as well as in Boston Scientific's Petition For Writ Of Certiorari in Case No. 09-362. Cordis' Palmaz stents were designed as metal tubes with longitudinal slots, leading to straight struts of metal that ran the length of the stent, as highlighted below:



While Cordis' Palmaz stents provided a high degree of radial strength, inclusion of such long, straight struts made these stents too rigid. They failed to achieve the necessary flexibility for delivery of the stent and for patient safety.

Cordis tried for years to improve the flexibility of its stents without sacrificing strength. In the early

1990's, Cordis contracted with Deka, an engineering consulting firm. Deka's attempts to improve the Palmaz stent resulted in the Crown stent, which replaced the straight metal struts of the Palmaz stent with wavy struts. This substitution is shown below in images from a video Cordis offered to the FDA in seeking regulatory approval of the Crown stent:

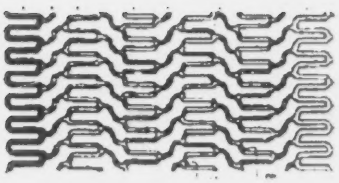


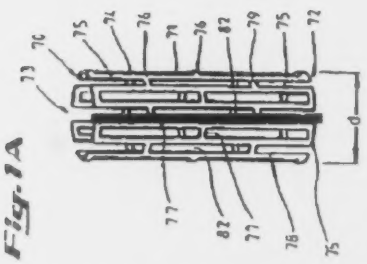
Cordis' efforts with the Crown stent failed to improve flexibility to a satisfactory degree. This was also true of Cordis' follow-on product, the Mini-Crown stent.

In the mid-1990's Cordis turned to another engineering company, Isostent. Isostent's work with Cordis led to the BX stent. But the BX stent was also unable to achieve the desired combination of strength and flexibility. Thus, Cordis continued to meet with other stent designers.

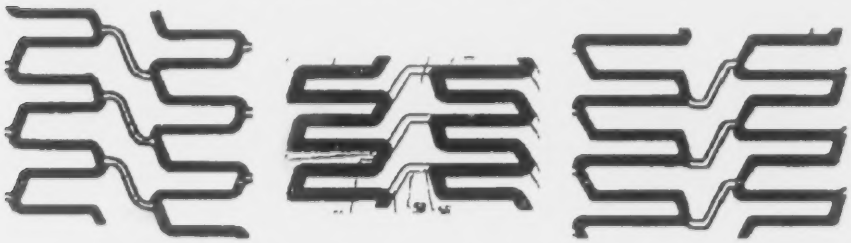
B. Dr. Jang's invention achieved both flexibility and strength through the use of offset, curvy connectors.

Dr. G. David Jang began his work on stent designs in the early 1990's. To achieve the desired combination of strength and flexibility, Dr. Jang went against the conventional wisdom. First, Dr. Jang chose to use discrete "expansion columns," which were comprised of metal struts extending along only a portion of the stent's longitudinal axis (highlighted below in blue), rather than the metal struts of Cordis' Palmaz, Crown and Mini-Crown stents, which ran the length of the device (highlighted in red):





By spacing discrete expansion columns along the length of the stent, Dr. Jang avoided the rigidity of Cordis' designs. Second, Dr. Jang connected these expansion columns with offset, curvy connectors. This increased the length of the connectors' lever arm, and as a result their flexibility, as well as allowing torquing between expansion columns for additional flexibility. At the same time, Dr. Jang retained a dense network of these connectors, preserving the stent's strength and scaffolding. These features are illustrated below, in various figures from the Jang '021 patent, with the expansion columns highlighted in blue and the offset, curvy connectors highlighted in yellow:



As Cordis' technical expert conceded at trial, the prior art feared that this "offset connector is completely the wrong thing to do" and the prior art was "concerned about twisting and they were avoiding a diagonal connector." As summarized by the Federal Circuit, the "prior art patents taught away from the bottom-to-top connectors described in

claim 36 by describing features of such connectors as potentially harmful." Pet. App. 20a. This was the critical feature that distinguished Dr. Jang's invention, and it allowed him to succeed where the prior art had failed.

The reference points for some of Dr. Jang's offset, curvy connectors were the "corners" of the expansion column. This was the location where the horizontal portions of the expansion column—or "expansion struts" in the parlance of the patent—were joined to the vertical portions—or "joining struts." It distinguished the apex of the joining struts, where some prior art had attached connectors. But the specific shape of the "corner" was inapposite to the novel offset, curvy connection scheme.

Although the district court construed the term "corner" as used in the claims of the Jang '021 patent to mean "a place where two surfaces meet *to form an angle*," the court noted that the Jang patent also embraced the use of rounded corners, or "semi-circular arcs" in Cordis' parlance:

> As noted by BSC, the rounded corner structure is not excluded from the '021 patent. In fact, the specification of the '021 patent states that "preferably corners 176 and 178 are rounded to remove sharp edges and provide increased flexibility" and that "rounded corners provide stent 10 with greater expandability and reduce stress in the stent strut material at the corners in the expanded stent."

Pet. App. 80a (citation omitted). Nowhere in the patent or the prosecution history—or anywhere else in the record—did Dr. Jang disclaim rounded

corners. Nor would such a distinction have been relevant to Dr. Jang's invention, which is characterized by offset, curvy connectors.

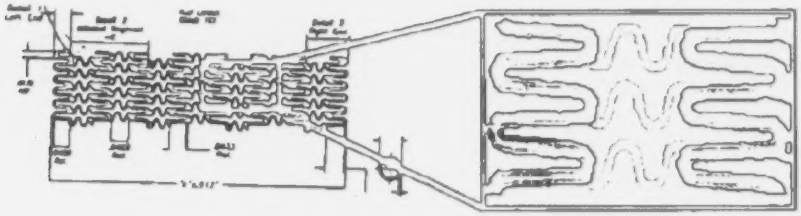
C. After meeting with Dr. Jang, Cordis launched Bx Velocity—a stent with offset, curvy connectors.

Following its experience with the Palmaz, Crown, Mini-Crown and BX stents, Cordis met with Dr. Jang. Cordis received a portfolio of Dr. Jang's designs, as well as documents explaining the disclosed features. As explained at trial by the Cordis executive tasked with stent research and development in the 1990's:

> Q: When is the first time you ever met Dr. Jang personally?
>
> A: I don't remember the precise date. Somewhere in the '95 to '97 time frame.
>
> * * *
>
> Q: Are you aware of [sic] that someone on behalf of Johnson & Johnson Cordis was negotiating with Dr. Jang in 1995 to '98 time frame?
>
> A: Yeah. Again, I'm not sure I would characterize it as negotiations. There were conversations that went back and forth with multiple letters to Dr. Jang with different iterations of his ideas of stents.
>
> Q: Did Cordis ever consider licensing any of those designs that Dr. Jang was discussing?
>
> A: Well, again, based on what I looked at yesterday, there was this ongoing dialogue.

> Whether this actually got to the point of considering a license or not is not clear to me.
>
> * * *
>
> Q: Is it your understanding that at some point in the discussions that were going on between Dr. Jang and Cordis and J&J, that Dr. Jang made an offer of his stent technology to Cordis J&J?
>
> A: Well, based on the [sic] reading the communication yesterday, it seems, yes, he made multiple offers of what he characterized as the best stent in the world.

However, Cordis did not license Dr. Jang's technology. Instead, it proceeded to launch a stent—the Bx Velocity shown below with offset, curvy connectors—without any authorization from Dr. Jang:



Although Cordis attempts to argue that the Bx Velocity contains "semi-circular arcs" at its ends, the district court determined that those are simply the "rounded corners" of Dr. Jang's patent:

> The rounded corners of the Bx Velocity stent are found where its expansion struts meet its joining struts, consistent with what is detailed in the '021 patent.

Pet. App. 79a. This same stent design with offset, curvy connectors was used in Cordis' Cypher, Bx Sonic and Genesis stents, versions of the Bx Velocity used for drug-elution, a different delivery catheter and peripheral arteries, respectively.[1] Using this design, Cordis' stents have achieved considerable commercial success.

II. Prior Proceedings

A. The "rounded corners" of Bx Velocity were found equivalent to the patented "corners" by the jury and district court.

Cordis filed a complaint against Boston Scientific on January 13, 2003 claiming, *inter alia*, alleged infringement of the Palmaz '762 patent.[2] On March 5, 2003, Boston Scientific filed a counterclaim for Cordis' infringement of the Jang '021 patent.

Boston Scientific's counterclaim was tried to a jury in June 2005. Cordis did not move for summary judgment with respect to infringement of the "corners" limitation, nor did it move in limine to exclude evidence or argument of infringement under the doctrine of equivalents. As summarized by the district court, Boston Scientific adduced evidence at trial that Cordis' "rounded corners" infringed the

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[1] Because there are no relevant differences between these four stents for purposes of infringement, they are collectively referred to herein as "Bx Velocity."

[2] The invalidity of the Palmaz '762 patent is the subject of Boston Scientific's Petition for Writ of Certiorari in Case No. 09-362.

claimed "corners" of the Jang '021 patent under the doctrine of equivalents:

> Dr. Moore provided testimony that the rounded corners of the Bx Velocity stent are equivalent to the "corners" that form angles. Additionally, Dr. Moore offered testimony regarding the application of the doctrine of equivalents to the corners of the Bx [V]elocity stent using a "function-way-result" analysis. In contrast, Dr. Buller, testifying as an expert for Cordis, did not offer an analysis under the "function-way-result" test . . . .

Pet. App. at 80a (citations omitted). Following this presentation of evidence, the district court charged the jury with, *inter alia*, the following instruction:

> If you find that the accused stents literally infringe all of the limitations of Claim 36 of the '021 patent except for the corners limitation, then you must consider whether the accused stents infringe that limitation under the doctrine of equivalents.
>
> * * *
>
> The test for determining equivalence under the doctrine of equivalents is whether the differences between the claim limitation which you have found not to be literally present and the element present in the accused products are insubstantial. In determining whether the differences are substantial or insubstantial, you may consider whether or not the claimed limitation and the element in the accused products perform substantially the same

> function in substantially the same way to produce substantially the same result.
>
> * * *
>
> [I]f you find that a claim limitation is not literally infringe[d], you must compare that claim to the corresponding element in the accused product to determine equivalents.

Cordis did not object to this instruction. Nor did Cordis object to the verdict form, which explicitly required the jury to consider the doctrine of equivalents for the "corners" limitation:

> 4. Has Boston Scientific shown by a preponderance of the evidence that the Cypher, Bx Velocity, Bx Sonic and Genesis stents infringe the "corners" limitation of claim 36 of the '021 patent under the doctrine of equivalents?
>
> | YES (A finding for Boston Scientific) | NO (A finding for Cordis) |
> | --- | --- |
> | ✓ | |

Following a verdict of infringement, the district court rejected Cordis' renewed motion for judgment as a matter of law challenging the sufficiency of the evidence presented at trial:

> With respect to the "corners" limitation of claim 36, the court construed that limitation to mean "a place where two surfaces meet to form an angle." . . . BSC introduced testimony that the rounded corners of the Bx Velocity stent found at the intersection of the expansion struts and joining struts perform substantially the same function in

> substantially the same way to achieve substantially the same result as corners that form angles. Based on the evidence offered, the differences between the rounded corners of the Bx Velocity stent and the "corners" described in claim 36 of the '021 patent appear to be minor variations like those contemplated by the Supreme Court in *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950) . . . .

Pet. App. 78-79a.

Cordis argued for the first time after the trial that legal bars such as the all-elements rule and the doctrines of vitiation and exclusion should have somehow barred the jury's consideration of infringement under the doctrine of equivalents. Pet. App. 78-80a. The district court rejected these arguments. *Id.*

B. The Federal Circuit affirmed the judgment of infringement under the doctrine of equivalents.

On September 24, 2007, Cordis appealed, *inter alia*, the judgment of infringement under the doctrine of equivalents. As the Federal Circuit concluded:

> The district court properly found that Boston Scientific presented sufficient expert testimony that Cordis's Bx Velocity stent meets the "corners" limitation of claim 36 under the doctrine of equivalents under the function-way-result test of *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U.S. 605, 608 (1950), a test that is still

> useful under *Warner-Jenkinson Co. v. Hilton-Davis Chemical Co.*, 520 U.S. 17, 39-40 (1997), particularly for mechanical inventions. Boston Scientific's expert Dr. Moore testified that the "corners" in claim 36 and the circular arcs or rounded corners of the Bx Velocity stent both function as actual and potential reference points for joining adjacent stent rings, fulfill this function through their similar locations, and can or do result in offset connections between rings.

Pet. App. 15-16a.

The Federal Circuit further found that: "The district court properly found that vitiation did not bar a doctrine of equivalents analysis here" and that rounded corners or circular arcs were not excluded or disclaimed in the prosecution history of the '021 patent. Pet. App. 16a & n.6. Accordingly, the Federal Circuit affirmed the judgment of infringement.

ARGUMENT

I. Infringement under the doctrine of equivalents was proper in this case.

A. For over 150 years, the doctrine of equivalents has been a fundamental part of United States patent law.

The doctrine of equivalents dates back to this Court's 1853 decision in *Winans v. Denmead*. *See Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950) (crediting *Winans* as the origin of the doctrine). In that case, the plaintiff's patent claimed a conical car for the transportation of coal—*i.e.*, a car with a circular cross-section—whereas the

defendant's product comprised a car with an octagonal cross-section. *Winans v. Denmead*, 56 U.S. 330, 330-31 (1853). This slight difference in shape was the basis for a directed verdict of non-infringement by the district court. *Id.* at 336.

The Court reversed the judgment, finding that "the property of inventors would be valueless, if it were enough for the defendant to say, your improvement consisted in a change of form; you describe and claim but one form; I have not taken that, and so have not infringed." *Winans*, 56 U.S. at 342-43. If such trivial substitutions were sufficient to escape liability for patent infringement, the value of a patent grant—and the policy underlying the patent system—would be greatly diminished.

This principle was reaffirmed by this Court a few years later in *Seymour v. Osborne*:

> Mere formal alterations in a combination in letters patent, however, are no defence to the charge of infringement, and the withdrawal of one ingredient from the same and the *substitution of another which was well known at the date of the patent as a proper substitute for the one withdrawn*, is a mere formal alteration of the combination if the ingredient substituted performs substantially the same function as the one withdrawn.

78 U.S. 516, 556 (1870) (emphasis added). As the Court concluded: "Patentees, therefore, are entitled in all cases to invoke to some extent the doctrine of equivalents . . . ." *Id.*

This approach continued as the Court revisited the doctrine over the ensuing decades: "A close copy

which seeks to use the substance of the invention, and, although showing some change in form and position, uses substantially the same devices, performing precisely the same offices with no change in principle, constitutes an infringement." *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929).

The doctrine of equivalents became a crucial part of patent protection, as repeatedly expressed by this Court's decisions:

> [C]ourts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions. . . . One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy.

Graver Tank, 339 U.S. at 607. This importance was echoed most recently by the Court in *Festo*:

> If patents were always interpreted by their literal terms, their value would be greatly diminished. Unimportant and insubstantial substitutes for certain elements could defeat the patent, and its value to inventors could be destroyed by simple acts of copying. . . . The scope of a patent is not limited to its literal terms but instead embraces all equivalents to the claims described.

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 731-32 (2002).

B. The doctrine of equivalents prevents infringers from substituting known equivalents to escape liability.

Although "[e]quivalence, in the patent law, is not the prisoner of a formula," *Graver Tank*, 339 U.S. at 609, certain standards have emerged over time for application of the doctrine. In the doctrine's first formulation, this Court mandated a factual inquiry into whether the accused product was similar enough:

> [A]s substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention. . . . It must be the same in kind, and effected by employment of his mode of operation in substance. Whether, in point of fact, the defendant's cars did copy the plaintiff's invention, in the sense above explained, is a question for the jury, and the court below erred in not leaving that question to them upon the evidence in the case, which tended to prove the affirmative.

Winans, 56 U.S. at 344. The applicable test was refined a few years later in *Union Paper-Bag Machine Co. v. Murphy*:

> [I]n determining the question of infringement, the court or jury, as the case may be, are not to judge about similarities or differences by the name of things, but are to look . . . *if it performs substantially the same function in substantially the same way to*

> *obtain the same result.* . . . [I]f two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape.

97 U.S. 120, 125 (1877) (emphasis added). This "function-way-result" test was cited favorably in *Sanitary Refrigerator*, 280 U.S. at 42, and *Graver Tank*, 339 U.S. at 608. And while not mandating its use, the Court recognized the continued suitability of the function-way-result test for mechanical devices—such as the stents at issue in this case—in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 39-40 (1997).

C. Cordis' "rounded corners" are, at a minimum, equivalent to the "corners" of Boston Scientific's patent.

Patent infringement requires comparison of an accused product with the limitations of a patent claim. *N. Am. Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 1344 (Fed. Cir. 2005); *Warner-Jenkinson*, 520 U.S. 520 at 29.

Cordis does not dispute that, at a minimum, the Bx Velocity literally satisfies all of the limitations of claim 36 of the Jang '021 patent other than the "corners" limitation. The only question is whether the "rounded corners" of the Bx Velocity literally or equivalently satisfy that limitation.

Although the district court construed "corners" to mean "a place where two surfaces meet *to form an angle*," the '021 patent specification discloses that "preferably corners 176 and 178 are *rounded* to remove sharp edges and provide increased

flexibility." Under a proper construction of "corners"—which should include the patent's preferred embodiment of "rounded corners"—Cordis' infringement was and is literal and its petition moot.[3]

But even if "rounded corners" are somehow not literally "corners," there was ample evidence adduced at trial that the two structures are substantially equivalent for purposes of the Jang '021 patent. As both the district court and Federal Circuit acknowledged, Boston Scientific offered a step-by-step analysis from its technical expert, Dr. James Moore, to explain how the Bx Velocity stent meets every limitation of claim 36. Pet. App. at 16a, 79a-80a.

Dr. Moore testified that the "rounded corners" in Bx Velocity are, at most, insubstantially different from the patent's "corners." *Id.* at 79a. And he testified that this equivalence was shown by, *inter alia*, application of the function-way-result test, which has repeatedly been endorsed by this Court. Pet. App. at 80a. Cordis did not offer any rebuttal testimony. *Id.*

Certain aspects of the stent art were discussed during prosecution, such as the "tubular members" of Cordis' Palmaz stent. But Dr. Jang never disclaimed

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[3] Boston Scientific filed a conditional cross-appeal of the district court's construction of "corners," arguing that under a proper construction Cordis' infringement is literal. As the Federal Circuit affirmed the verdict of infringement under the doctrine of equivalents, it did not address Boston Scientific's conditional cross-appeal.

"rounded corners." Quite the opposite, Dr. Jang criticized "sharp right angled bends" because they allow for "catching and snagging on the vessel wall during delivery." Cordis' assertion that "Jang preferred angular corners" overlooks this portion of Dr. Jang's patent and is erroneous. Pet. at 11.

In fact, Dr. Jang's "corners" and Cordis' "rounded corners" were treated equivalently during prosecution of the Jang '021 patent. And they were treated as equivalent by Cordis for purposes of its invalidity defenses at trial. No distinction between the two was ever drawn, supporting the jury's determination that the two structures are, at a minimum, equivalent, if not identical.

D. No legal bar to the doctrine of equivalents exists in this case.

Following the jury's verdict of infringement, Cordis filed a post-trial motion arguing for the first time that the doctrine of equivalents should not have applied as a matter of law due to the all-elements rule and the doctrines of vitiation and exclusion.

The all-elements rule bars the doctrine of equivalents where no equivalent structure is identified. *Warner-Jenkinson*, 520 U.S. at 39 n.8. But an equivalent structure was identified in this case—Cordis' "rounded corners." As a result, the district court and Federal Circuit rejected this argument. Pet. App. at 15a-16a, 78a-80a.

The doctrine of vitiation bars the doctrine of equivalents where the theory of infringement removes any meaning from the claim limitation. *Freedman Seating Co. v. Am. Seating Co.*, 420 F.3d 1350, 1359 (Fed. Cir. 2005). But the trial evidence

showed a specific function-way-result for the claimed "corners," and proved that Cordis' "rounded corner" provided substantially the same function-way-result. Pet. App. at 80a. This did not remove all meaning from the limitation. For this reason, Cordis' argument regarding vitiation was rejected as well. *Id.* at 78a-80a.

The exclusion doctrine bars the doctrine of equivalents where it would recapture a structure explicitly disclaimed by the patentee. *Honeywell Int'l, Inc. v. ITT Indus., Inc.*, 452 F.3d 1312, 1321 (Fed. Cir. 2006). But Dr. Jang never disclaimed "rounded corners." Rather, as discussed above, he expressed a *preference* for them. Thus, this argument by Cordis also failed. Pet. App. at 80a.

E. No bar exists merely because an infringer's equivalent structure was known to be equivalent at the time of patenting.

Having lost on the merits of the doctrine of equivalents, and having lost on its three alleged legal bars to the doctrine of equivalents, Cordis petitions this Court for yet another opportunity to argue for a legal bar to the doctrine of equivalents. Having never timely raised this new argument, Cordis has waived it and it need not be heard on appeal. But even if the Court were to consider Cordis' argument—that the doctrine of equivalents somehow cannot apply to structures known to be equivalent at the time of patenting—that argument fails in light of a century of Supreme Court precedent to the contrary.

1. Cordis waived its argument for such a bar by never raising it at trial.

"Generally, a party who does not clearly and specifically object to a charge . . . believe[d] to be erroneous waives the issue on appeal." *Bostic v. Smyrna School Dist.*, 418 F.3d 355, 359 (3d Cir. 2005); *see also Hormel v. Helvering*, 312 U.S. 552, 556 (1941) ("Ordinarily an appellate court does not give consideration to issues not raised below."). This requirement serves "important policy goals," such as affording the trial court an opportunity to correct errors as well as lessening the judicial burden of post-trial review by excluding newly developed arguments. *See Fashauer v. New Jersey Transit Rail Operations*, 57 F.3d 1269, 1288 (3d Cir. 1995).

The question of infringement of the "corners" limitation under the doctrine of equivalents was explicitly raised in the jury instructions and verdict form, to which Cordis acceded. By failing to object, Cordis waived any right to later dispute the jury's consideration of the doctrine of equivalents. *Cf. B. Braun Med. Inc. v. Abbott Labs.*, 892 F. Supp. 112, 114 (E.D. Pa. 1995) (holding that acquiescence to jury instruction on the doctrine of equivalents waived objection to submitting issue to the jury). Thus, the court need not even address the merits of Cordis' petition.

2. For over 100 years, the Court has applied the doctrine of equivalents to equivalent structures known at the time of patenting.

If considered on the merits, Cordis' Petition should still fail. As stated by this Court over a century ago, infringement under the doctrine of

equivalents is properly found where "the substitute performs the same function *and was well known at the date of the patent as a proper substitute for the one omitted from the patented invention.*" *Fuller v. Yentzer*, 94 U.S. 299, 300 (1876) (emphasis added).

This Court's decisions have repeatedly reaffirmed that holding. *See, e.g.*, *Gould v. Rees*, 82 U.S. 187, 193 (1872) ("Unquestionably the withdrawal of one ingredient in a patented combination and the substitution of another *which was well known at the date of the patent as a proper substitute* . . . would not avoid the charge of infringement.") (emphasis added); *Seymour*, 78 U.S. at 556 (noting that the doctrine of equivalents applies to a substitute "which was well known as a proper substitute . . . *when the former invention was patented.*") (emphasis added); *Clough v. Gilbert & Barker Mfg. Co.*, 106 U.S. 166, 178 (1882) (finding infringement under the doctrine of equivalents where the alterations "perform the same office in substantially the same way as, and *were known equivalents for*, [the patented element]") (emphasis added); *Gill v. Wells*, 89 U.S. 1, 30 (1874) ("[T]he substituted ingredient cannot be regarded as a legal equivalent, within the meaning of the Patent law, unless it performs substantially the same function as the ingredient withdrawn, and *was well known as such an ingredient at the date of the original patent and as a proper substitute for the ingredient which was included in the patented combination.*") (emphasis added); *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 13 (1946) (requiring that equivalent structures have been "known at the date of [the] patent as a proper substitute"), *superseded by statute on other grounds*, 35 U.S.C. § 112 ¶ 6, *as recognized in Valmont Indus.*,

Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042 (Fed. Cir. 1993); *Graver Tank*, 339 U.S. at 612 (noting that "[i]t is difficult to conceive of a case more appropriate for the doctrine of equivalents" than where "*the infringer's alteration was known at the time of patenting to be an equivalent substitute*" to the claimed element) (emphasis added). As noted in Cordis' Petition, this rule was implicitly reaffirmed most recently in the Court's 1997 decision in *Warner-Jenkinson*. Pet. at 19-20.

In sum, this Court has repeatedly rejected the argument raised in Cordis' Petition for over a century. There is no reason for this Court to change course now.

II. The Court's decision in *Festo* addresses prosecution history estoppel, which is inapposite to this case.

Cordis' argument that a century of this Court's precedent is no longer good law is premised on a misreading of this Court's decision in *Festo*. Pet. App. at 20. According to Cordis, *Festo* "reversed the nineteenth century mode of analyzing" equivalents known at the time of patenting. Pet. at 20. *Festo*, however, addressed the doctrine of prosecution history estoppel, not equivalents in general: "When, however, the patentee originally claimed subject matter alleged to infringe, but then narrowed the claim in response to a rejection, he may not argue that the surrendered territory comprised unforeseen subject matter that should be deemed equivalent." *Festo*, 535 U.S. at 733-34. And it is undisputed that prosecution history estoppel does not apply in this case.

Cordis' argument that *Festo's* "logic applies with equal force" to non-prosecution history estoppel cases and somehow fundamentally altered the doctrine of equivalents ignores the context and explicit language of *Festo*, as well as its admonition that "the doctrine of equivalents and the rules of prosecution history estoppel are settled law. *The responsibility for changing them rests with Congress.*" *Id.* at 739 (emphasis added).

A. Prosecution history estoppel is a narrow limitation on the doctrine of equivalents.

Prosecution history estoppel is a "well-established limitation on the doctrine of equivalents." *Warner-Jenkinson*, 520 U.S. at 18. It dates back to the Court's early decisions on the doctrine:

> It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent. . . . The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer. . . . [T]he patentee, having acquiesced in their rejection, is no longer free to gain the supposed advantage of the rejected claims by a construction of the allowed claims as equivalent to them.

Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211, 220-222 (1940).

It is the act of amending a claim during prosecution that creates an affirmative *surrender* of patent scope on which the public is entitled to rely. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136 (1942) ("By the amendment [the patentee] recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference."). The estoppel has a specific purpose—to ensure that the patent claims are interpreted by reference to those claims "that have been cancelled or rejected"—and applies only to the situation where "the original application once embraced the purported equivalent but the patentee narrowed his claims [during prosecution] to obtain the patent or to protect its validity." *Festo*, 535 U.S. at 733-734 (citing *Schriber-Schroth*, 311 U.S. at 220-221).

The bases and application of prosecution history estoppel are different from those relating to the doctrine of equivalents as applied to unamended claims. *See, e.g., Exhibit Supply,* 315 U.S. at 136. Inclusion of a "limiting phrase" in the original patent application presents a "*very different issue*" from the situation in which "the applicant in order to meet objections in the Patent Office . . . adopted the [narrower] phase as a substitute for the broader one." *Id.* (emphasis added). "By the amendment he recognized and emphasized the difference between the two phrases and *proclaimed his abandonment* of all that is embraced in that difference." *Id.* (emphasis added). Where the patentee explicitly disclaims patent scope in order to distinguish the prior art, the amended claim must be "strictly construed" against him. *Id.* at 137. But no such

rule applies to unamended claims, or to those without such an explicit surrender of scope.

B. The question presented in *Festo* was the applicable test for prosecution history estoppel.

In *Festo*, this Court reviewed the Federal Circuit's holding that "by narrowing a claim to obtain a patent, the patentee surrenders *all* equivalents to the amended claimed element." 535 U.S. at 727 (emphasis added). This inquiry presented two specific questions: "the first question in this case concerns *the kinds of amendments that may give rise to estoppel*"; and the second question was "[d]oes the estoppel bar the inventor from asserting infringement against any equivalent *to the narrowed element* or might some equivalents still infringe?" *Id.* at 735-737 (emphasis added). The underlying Petition in *Festo* phrased the two questions similarly: "1) Whether every *claim—narrowing amendment* designed to comply with any provision of the Patent Act—including those provisions not related to prior art—automatically creates prosecution history estoppel regardless of the reason for the amendment; and 2) Whether *the finding of prosecution history estoppel* completely bars the application of the doctrine of equivalents." Petition for Writ of Certiorari at 1, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002) (No. 00-1543), 2001 WL 34091958 (emphases added). Both questions explicitly address prosecution history estoppel. Neither addresses patent claims granted without narrowing amendments, as in this case. *See* Sup. Ct. R. 14.1(a) ("Only the questions set forth in

the petition, or fairly included therein, will be considered by the Court.").

Cordis cites no authority to support its argument that *Festo* is "applicable to *all* claim limitations," rather than only to claim limitations that were narrowed during prosecution. Cordis also fails to provide any support for its argument that *Festo* somehow "calls into question" *Warner-Jenkinson's* continuation of the rule that the doctrine of equivalents applies to equivalents known at the time of patenting. Pet. at 20.

Festo cautions against adopting the type of bright-line rule advocated by Cordis, warning that it would "provide[] more certainty . . . but at the cost of disrupting the expectations of countless existing patent holders." *Festo*, 535 U.S. at 739. *Festo* also emphasizes that "[f]undamental alterations" in settled rules would "risk destroying the legitimate expectations of inventors in their property." *Id.* *Festo* explicitly left such sweeping changes to the doctrine of equivalents in the hands of Congress. *Id.*

Notably, *Festo* affirmed the central tenet of the doctrine of equivalents—that some flexibility in the scope of a patent is necessary to afford value to the patent grant and to prevent "efforts of copyists to evade liability for infringement by making only insubstantial changes to a patented invention." *Id.* at 727. Thus, *Festo* affirmed that the doctrine of equivalents properly applies in cases such as this one.

C. Cordis' reading of *Festo* is not supported by caselaw or commentary.

For at least 60 years, this Court has consistently distinguished between patent claims that had been amended during prosecution and those that had not for purposes of the doctrine of equivalents. *See, e.g.*, *Exhibit Supply*, 315 U.S. at 136 ("Whatever may be the appropriate scope and application of the doctrine of equivalents where a claim is allowed without a restrictive amendment, it has long been settled that recourse may not be had to that doctrine to recapture claims which the patentee had surrendered by amendment."). *Festo* explicitly addressed the former. Given the long-standing distinction between the two, there is no basis to read *Festo* as also somehow implicitly addressing the latter.

Notably, no case supports Cordis' reading of *Festo*. The Federal Circuit has cited *Festo* for controlling law only on issues related to prosecution history estoppel. *See, e.g., Felix v. American Honda Motor Co.*, 562 F.3d 1167, 1181-82 (Fed. Cir. 2009) (citing *Festo* for law on presumptions created by amendment-based prosecution history estoppel); *Salazar v. Procter & Gamble Co.*, 414 F.3d 1342, 1344 (Fed. Cir. 2005) (citing *Festo* for the proposition that "[t]he doctrine of prosecution history estoppel serves to limit the doctrine of equivalents when the applicant makes a narrowing amendment for purposes of patentability"); *Regents of Univ. of Cal. v. Dakocytomation Cal., Inc.*, 517 F.3d 1364, 1376 (Fed. Cir. 2008) (citing the requirements set forth by *Festo* to support its holding that the district court erred by applying prosecution history estoppel to the claim limitation); *Honeywell Int'l Inc. v. Hamilton*

Sundstrand Corp., 370 F.3d 1131, 1139-1140 (Fed. Cir. 2004) (citing *Festo* for controlling law on prosecution history estoppel).

Legal commentary has also cited *Festo* as controlling law only for prosecution history estoppel issues. *See, e.g.*, Donald S. Chisum, Chisum on Patents § 18.02[6] (2009) ("In *Festo*, the Court addressed the relationship between the doctrine of equivalents and prosecution history estoppel."). 4 R. Carl Moy, Moy's Walker on Patents § 13:77 (4th ed.) (citing *Festo* in support of prosecution history estoppel as an affirmative defense to infringement under the doctrine of equivalents).

Courts have rejected arguments to expand the scope of *Festo's* holdings beyond prosecution history estoppel. *See, e.g., A.G. Design & Assoc. LLC v. Trainman Lantern Co.*, 271 Fed. Appx. 995, 998 (Fed. Cir. 2008) (separating "*Festo* prosecution history estoppel tangential rebuttal analysis" from the "doctrine of equivalents function-way-result test") (unpublished); *Dethmers Mfg. Co. v. Automatic Equipment Mfg. Co.*, 299 F.Supp.2d 903, 918 (N.D. Iowa 2004) (rejecting argument that *Festo* applies to the "recapture rule").

The only court known to Respondents to have addressed Cordis' proposed reading of *Festo* as barring application of the doctrine of equivalents to equivalents known at the time of patenting rejected such an interpretation. In *Ranbaxy Laboratories Ltd. v. Abbott Laboratories*, the defendant argued that:

> [T]he *Festo* doctrine bars application of the doctrine of equivalents because [the alleged equivalents] were well-known in the

> pharmaceutical art at the time the patent application was filed. Thus, the patent specification and/or claims could have included such substances. Because the inventors did not include them, they cannot be considered equivalent . . . .

No. 04 C 8078, 05 C 1490, 2005 WL 3050608, *21 (N.D. Ill. Nov. 10, 2005), *aff'd sub. nom.*, *Abbott Labs. v. Andrx Pharmaceuticals, Inc.*, 473 F.3d 1196 (Fed. Cir. 2007). The district court rejected the argument, stating that "[t]he Festo doctrine only applies when a claim has been amended and thereby narrowed during patent prosecution." *Id.* No caselaw has held to the contrary.

Cordis' reliance on the Federal Circuit's decision in *Freedman Seating Co. v. American Seating Co.* is inapposite. That case addressed the doctrine of vitiation—a doctrine Cordis unsuccessfully raised before the district court and Federal Circuit but did not raise in its Petition. *Freedman Seating*, 420 F.3d at 1361-62. Briefly, that case concerned a claim limitation requiring that a structure be "slidably mounted" and an accused product in which the corresponding structure "cannot slide or otherwise move . . . [i]t is confined to a fixed location." *Id.* The Federal Circuit found that this "is not a 'subtle difference in degree,' but rather, 'a clear, substantial difference or difference in kind.'" *Id.* (citation omitted). Although the opinion discussed the patentee's awareness of the alleged equivalents at the time of patenting, *e.g.*, *id.* at 1362, this fact was inapposite to the holding. It was the issue of vitiation—a removal of any meaning of the claim

limitation—that was the basis for the court's decision. *Id.* at 1361.

Cordis' reliance on *Sage Products., Inc., v, Devon Industries, Inc.*, 126 F.3d 1420 (Fed. Cir. 1997) is similarly misplaced. In that case, the Federal Circuit affirmed summary judgment of noninfringement where the factual record showed that two claim limitations were not present in the accused device, either literally *or equivalently*: "The record does not show that Sage presented any perspective on Devon's accused products that simultaneously satisfied an insubstantial variation of both of these limitations." *Id.* at 1424. It was not a question of whether alleged equivalents were known at the time of patenting. Rather, the issue was a lack of evidence of equivalence. *Id.*

Confronted with this fact, the appellant proffered a second theory of equivalence purportedly based on the entire claim, but divorced from the claim's limitations. The Federal Circuit rejected this approach because "the doctrine of equivalents does not grant Sage license to remove entirely the [two] limitations from the claim." *Id.* at 1424. Again the issue was vitiation—whether the claim limitation was being ignored—rather than whether an alleged equivalent was known at the time of patenting. *Id.* at 1424-25.

Sage Products does not evidence any confusion by the Federal Circuit with respect to the doctrine of equivalents. The issue raised therein was squarely addressed by this Court in *Warner-Jenkinson*, which similarly held that the doctrine of equivalents properly applies to *limitations* of a patent claim, rather than the invention as a whole. 520 U.S. at 29-

30. This precedent is inapposite to Cordis' Petition because Boston Scientific properly presented a doctrine of equivalents case for a specific limitation—"corners"—rather than for the claim as a whole. Notably, Cordis previously raised a vitiation defense but it was rejected by the district court and Federal Circuit, and is no longer at issue.

III. Cordis' Petition addresses a matter of private interest with no broader implications for the Court's established precedent.

Cordis argues that application of the doctrine of equivalents to interchangeable substitutes that were known at the time of patenting—as allegedly occurred in this case—"creates uncertainty about the scope of patent protection" which somehow "can impede legitimate competition." Pet. at 3. But the doctrine of equivalents has always extended a patent scope beyond its strict, literal terms. *See Festo*, 535 U.S. at 732 ("The scope of a patent is not limited to its literal terms but instead embraces all equivalents to the claims described."); *LG Elecs., Inc. v. Bizcom Elecs., Inc.*, 453 F.3d 1364, 1380 (Fed. Cir. 2006), (noting that the doctrine of equivalents, "by its very nature, extends beyond the patent's literal claim scope because otherwise a finding of no literal infringement would be a foreordained conclusion of no infringement at all"), *rev'd sub nom. on other grounds, Quanta Computer, Inc. v. LG Elecs., Inc.*, 128 S. Ct. 2109 (2008). This case is thus no different than every other doctrine of equivalents case that has come before the Court in the last 150 years.

In essence, Cordis ask this Court to reverse 150 years of its precedent and change the balance struck

by the doctrine of equivalents—a task this Court has repeatedly declined in deference to Congress. *See Festo*, 535 U.S. at 739; *Warner-Jenkinson*, 520 U.S. at 28. While this case may address a matter of private interest as between the parties, it offers nothing new to alter this Court's longstanding doctrine of equivalents precedent:

> It is true that the doctrine of equivalents renders the scope of patents less certain. . . . These concerns with the doctrine of equivalents, however, are not new. Each time the Court has considered the doctrine, it has acknowledged this uncertainty as the price of ensuring the appropriate incentives for innovation, and it has affirmed the doctrine over dissents that urged a more certain rule. . . . More recently, in *Warner-Jenkinson*, the Court reaffirmed that equivalents remain a firmly entrenched part of the settled rights protected by the patent. A unanimous opinion concluded that if the doctrine is to be discarded, it is Congress and not the Court that should do so.

Festo, 535 U.S. at 732-33.

Cordis' policy arguments were considered, and resolved, over 150 years ago when this Court first articulated the modern doctrine of equivalents:

> Will this [equivalent] be the limit to that claim? Who can tell the bounds within which the mechanical industry of the country may freely exert itself? What restraints does this patent impose in this branch of mechanic art?

Winans, 56 U.S. at 347 (J., Campbell, dissenting). Those fears were acknowledged, and overcome, by the Court's majority opinion. And as discussed herein, every decision by this Court since *Winans* has reaffirmed the conclusion that the benefits of preserving a patent's value outweigh the potential reduction of certainty as to the patent's scope.

Cordis' warnings of unbridled application of the doctrine of equivalents overlooks the limited role of the doctrine. As discussed above, it can only apply to a specific claim limitation and not to the invention as a whole—all of the other limitations of a patent claim must still be literally present in the accused product. *See Warner-Jenkinson*, 520 U.S. at 29 (noting that equivalency only applies to specific elements and not to the overall invention). It cannot be used to vitiate a claim limitation. *Freedman Seating,* 420 F.3d at 1359. It cannot be used if the equivalent structure was disclaimed by the patentee. *ITT Indus.*, 452 F.3d at 1321. And, as this Court held in *Festo*, it presumptively cannot be used for elements added during prosecution to distinguish prior art. *Festo*, 535 U.S. at 740-41.

But most importantly, the doctrine of equivalents does not apply unless the accused product contains an *equivalent* structure. Plaintiffs bear the burden of proving this equivalence by a preponderance of the evidence. *Datascope Corp. v. SMEC, Inc.*, 776 F.2d 320, 325 (Fed. Cir. 1985).

For example, in this case, it required proof by a preponderance of the evidence that Cordis' "rounded corners" performed substantially the same function in substantially the same way to achieve substantially the same result as the "corners"

claimed in the Jang '021 patent. This proof of equivalence was not contested at trial—Pet. App. at 80a—and is not contested in Cordis' Petition.

These safeguards prevent the doctrine of equivalents from running roughshod over legitimate competition and implicating the policy concerns cited by Cordis. And in any event, as this Court has repeatedly affirmed for 150 years, any uncertainty engendered by the doctrine of equivalents is necessary lest the law "encourage [] the unscrupulous copyist to make unimportant and insubstantial changes and substitutions." *Graver Tank*, 339 U.S. at 607.

The private dispute presented by Cordis' Petition falls squarely within controlling law. Having met with Dr. Jang and learned of his stent designs, Cordis launched a new product that literally embodied every claim limitation, with the sole exception that its "rounded corners" are somehow allegedly different than the patent's "corners." Cordis does not dispute that any such difference is "unimportant and unsubstantial." Nor does Cordis dispute that the two structures are equivalent under the "function-way-result" test. By attempting to bar recourse to the doctrine of equivalents in this case, Cordis seeks to frustrate the very policy on which the doctrine was founded.

While the Court's review of the merits of this case may be of interest to Cordis and Boston Scientific, nothing in Cordis' Petition provides the opportunity for the Court to speak beyond what it has already clearly and repeatedly expressed over the last 150 years. Cordis' Petition is properly denied.

CONCLUSION

For all of the foregoing reasons, Respondents respectfully submit that this Court should deny Cordis' petition for writ of certiorari.

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